The application is made too late and in bad faith. *Flowerdale Ltd.* v. *Hale Electric Co. Ltd.*(2); *Agfa A.G.* v. *Ilford Ltd.*(3)).

In the course of the trial judgment was entered against the defendants by consent.

Raja Azlan Shah J.: As to which of the alternative reliefs the plaintiffs will be entitled to is a discretion of the court to be granted on the evidence before the court. Whether or not there should be a stay of action is also a discretion of the court. In the circumstances of this case the court will not grant a stay and the action must proceed.

Judgment for the plaintiffs by consent.

Solicitors: *Shook Lin & Bok; Shearn, Delamore & Co.*

LEE KAR CHOO v. LEE LIAN CHOON

[P.C. (Lord Morris of Borth-y-Gest, Lord Hodson and Sir Garfield Barwick) October 4, 1966]

[Privy Council Appeal No. 26 of 1965]

Trade Marks — Passing off — Infringement — Finding that respondent's labels were calculated to enable his goods to be passed off as appellant's goods — No infringement but passing off — Whether consistent.

Passing off — Get-up of goods — Risk of confusion — Customers illiterate persons who ordered goods by reference to prominent feature on label — No infringement of appellant's trade mark, but relief granted on ground of passing off.

This was an appeal from the judgment and order of the Federal Court ([1965] 1 M.L.J. 249) setting aside a decision of the High Court. The learned trial judge had found that there had been no infringement of the appellant's trade mark and that the evidence did not support the contention of the possibility of confusion because of the respective labels in the minds of the public. He nevertheless held that the appellant had used the mark in a manner which had enabled the retailers to practise a deceit on the public and he therefore, made an order restraining the respondents from using the labels complained of. On appeal the Federal Court set aside the decision of the trial judge on the ground that as the trial judge had found that there had been no infringement of the trade mark and that the get-up of the trade mark of the respondent would not lead to confusion in the minds of the public he should have dismissed the action. The appellants appealed to the Privy Council.

Held: (1) the finding of the learned trial judge that the respective labels did not cause actual confusion and that the evidence did not support a contention that such confusion was possible was not inconsistent with his finding that, none the less particularly in the community in which the appellant's and respondent's tea was retailed, the emphasis by the respondent in his label of an essential part of the appellant's trade mark was calculated to enable a passing off to take place;

(2) the learned trial judge had come to a correct finding on the evidence and on the pleadings and therefore, the appeal must be allowed and the orders of the trial judge restored.

Cases referred to:—

(1) *Singer* v. *Loog* (1880), 18 Ch. D. 395 at p. 412.

(2) *Schweppes Ltd.* v. *Gibbens* 22 R.P.C. 113.

(3) *Saville Perfumery Ltd.* v. *June Perfect Ltd.* 58 R.P.C. 147.

(4) *Cordova & Ors.* v. *Vick Chemical Co.* 68 R.P.C. 103.

The following cases, in addition to those referred to in the judgment of the Board, were cited in argument: *Johnston* v. *Orr Ewing* (1882), 7 App. Cas. 219; *Lever* v. *Goodwin* (1887), 36 Ch. D. 1, 3 T.L.R. 650, 4 R.P.C. 492; *Reddaway* v. *Banham* [1896] A.C. 199, 12 T.L.R. 295, 13 R.P.C. 218; *Brinsmead* v. *Brinsmead* (1913), 30 R.P.C. 493; *Middlemas & Wood* v. *Moliver & Co. Ltd.* (1921), 38 R.P.C. 97; *White Hudson & Co.* v. *Asia Organization Ltd.* [1965] M.L.J. 186, [1965] R.P.C. 45; and *Eli Lilly & Co.* v. *Chelsea Drug Chemical Co. Ltd.* [1966] R.P.C. 14.

PRIVY COUNCIL.

Patrick Graham, Q.C. and *G. D. Everington* for the appellant.

P. Stuart Bevan for the respondent.

Sir Garfield Barwick: This is an appeal from a judgment and order of the Federal Court of Malaysia setting aside an order of the High Court of the Federation of Malaya granting an injunction to restrain passing off, and ancillary relief.

Lee Kar Choo, the appellant, of Market Street, Ipoh, Perak, has been trading as Yeen Thye Company for some 22 years in tea and tea dust, some of which he has sold throughout that period in packets of foil wrapped with a label which prominently displays a red coloured gold fish swimming in water contained in a scroll surrounded by flowers, upon a background of red, the whole being enclosed within a yellow frame. This device was as large as the larger side of the rectangular package and was repeated on each such side. On one end of the package, the gold fish appeared upon a background of yellow on which was written in several languages, including English, the words " 'Gold Fish' Best Quality Ceylon Tea Dust" and a telephone number, with a black and red border and a yellow surround. On the other end the gold fish appeared on a similar background with the same legend written in Chinese characters.

In 1952 the appellant registered a coloured representation of the larger section of this label as a trade mark under the provisions of the Trade Marks Ordinance of the Federation of Malaya in class 30 in respect of tea and tea dust. This registration was for a period of seven years. At the time of its registration the appellant gave an undertaking to use the mark only in colours exactly as in the specimen in the form of application for registration, *i.e.*, as earlier described. However, it has been held by the courts below and not questioned before their Lordships, that none the less the appellant was not entitled to the benefit of that part of section 22 of the Trade Marks Ordinance that required the colouring to be taken into account when considering

the distinctive character of the mark. In 1956 the appellant applied for the renewal of the registration of this trade mark for a period of 14 years and it was so renewed as from 14th March 1959. At that time the appellant also registered a representation in the same colours of the whole of his label, including the portions covering the ends of the package, as a trade mark under the Ordinance under class 30 in respect of tea and tea dust, the registration being for seven years from 23rd March 1959. In this instance no undertaking was given as to the colours in which the mark should be used.

As might well be expected and as the learned judge of first instance found, the label not only became itself distinctive of the appellant's tea and tea dust, but that commodity sold in packages so labelled came to be dealt in by the public as red fish or gold fish or simply fish, brand tea.

In the middle of 1960 Lee Lian Choon the respondent trading as Chuan Lee Company of Ipoh applied to register as a trade mark under the said Ordinance in class 30 in respect of tea and tea dust a representation of three fishing trawlers fish nets in the sea with fish of various sizes appearing both within and without the nets, principally in or near that net which appeared to be closest to the viewer. This mark was wholly depicted in black and white and topped with the caption "Fishing Nets Brand" prominently and boldly written. This application was granted and the mark registered for a period of seven years from 22nd June 1960. Apparently, the respondent was at this time, as the appellant in evidence said, "a newcomer" — at least as far as concerned dealings in tea and tea dust.

In 1961 the appellant ascertained that the respondent was selling tea in foil packets of comparable size to those sold by the appellant, got up in the same general colours of red and yellow with a label somewhat resembling the respondent's trade mark with trawlers and fishing nets but in which the two largest and most prominently placed fish were coloured red on a pale yellow background in a frame surrounded by flowers. He commenced a suit against the respondent to restrain passing off but compromised it upon the respondent undertaking to change his label in certain respects, which did not include the colouring of the fish, and not to infringe the appellant's mark or pass off his goods as those of the appellant.

Thereafter the respondent made some changes in his label. The colouring remained the same, with the two largest and most prominent fish being coloured red, though the surrounding border of flowers was replaced by Chinese characters and the words "Fishing Nets Brand" suppressed to the point of practical illegibility by being printed in yellow, against a very slightly paler yellow background. On the ends of the packages, the label displayed a fish coloured red with some faint lines in red to represent a fishing net in a trawler position, superimposed on the legend " 'Fishing Nets Brand' Best Quality Ceylon Tea Dust", at one end in English and in the characters of two other languages and on the other end in Chinese characters. These ends had a black and red border with a yellow surround.

Continued selling by the respondent in foil packages with this label resulted in a suit brought by the appellant for infringement of the appellant's said trade marks and for passing off. In his statement of claim the appellant claimed "the red coloured fish contained in a scroll and swimming in water" as a prominent feature of the distinctive get up of his tea and claimed that the use by the respondent upon packages of tea and tea dust of the label which has been described was an infringement of his trade marks and was "calculated to lead and has in fact led to deception and to the belief that the defendant's (respondent's) tea is the tea of the plaintiff (appellant) and is further calculated to cause and must have caused tea not of the plaintiff's manufacture or merchandise to be passed off as and for tea of the plaintiff . . ."

The respondent besides denying the infringement and the passing off set up the right given to him by section 52 of the Ordinance to use his own registered mark.

Their Lordships have had the benefit of seeing packets of tea made up for sale with his label by the appellant and by the respondent respectively. They have also seen packets of tea made up for sale in the markets in which the tea of the parties to the action was being sold and have been able to observe that red and gold are colours in which tea in foil packets is commonly wrapped or labelled.

The judge of first instance found that "members of the public wanting the appellant's tea asked for either fish brand or red fish brand in the Malay language. They are all illiterate class of people". There was abundant evidence to support this finding: and indeed, as their Lordships understand the learned judge's expressions, this fact was not substantially challenged before him.

It was proved by their own evidence, which the trial judge believed, that two traders, when asked for the appellant's tea under the description gold fish or fish brand, knowingly supplied the respondent's tea, packaged as described. It is clear from the reasons for judgment given by the trial judge that tea and tea dust were not dealt in in the local markets by reference to or by comparison with a label as a whole but

apparently by a description derived from a prominent feature of it.

The learned trial judge held that the respondent's label did not infringe the appellant's registered trade mark. He rejected the appellant's contention that "there was actual confusion by the respective labels in the minds of the public". He thought that the evidence of the two traders taken as a whole "failed to support the appellant's contention of the possibility of confusion". Having thus expressed himself, he said, referring to the two traders, "However, they both stated that they themselves had been guilty of practising a deceit on customers by supplying the customers least likely to cause trouble to them with defendant's (respondent's) tea knowing that what they really wanted was that of the plaintiff (appellant). This left me to consider whether or not, having regard to the fact that the defendant has emphasised in his trade mark an essential part of the plaintiff's trade mark and that there was no possibility of public confusion, the defendant ought to be restrained."

The difficulties which have arisen in this case spring from these passages in the trial judge's reasons for judgment. Having considered the judgment as a whole, it seems to their Lordships that the judge in the passage lastly quoted had in mind the claim of the appellant in his pleading to which reference has earlier been made. The principles to be applied in relation to such a claim are not in doubt. For present purposes, their Lordships are content to refer to one of the earliest statements, namely, that of James L.J. in *Singer* v. *Loog*,[1]

> ". . . no man is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer."

Having examined certain authorities the judge quoted, with emphasis, from the judgment of Warrington J. in *Schweppes Ltd.* v. *Gibbens*,[2]

> "it is sufficient to enable the plaintiff to succeed if he can show that the get up, the label, or whatever it may be, is of such a nature as is calculated to enable the retail vendor to deceive the ultimate customer."

It is thus apparent that the trial judge understood the principles to be applied in and intended to deal with a claim that the respondent had, by the use of this label, placed an instrument of fraud in the hands of those who purchased from him. Ultimately, having laid stress on the local manner of trading in tea and tea dust, the judge said, "Having come to the conclusion therefore that the defendant has used his trade mark in a manner which has enabled retailers to practise a deceit on the public obviously asking for the plaintiff's brand as opposed to the defendant's brand and although I am not prepared to make a finding of anything in the nature of fraudulent intent or deliberate intent to deceive, I feel bound on the authorities to which I have referred to make an order restraining the defendant from using the labels complained of." He therefore granted an injunction restraining the use of the respondent's labels and made an order for the delivery to the appellant of the stocks of such labels in the respondent's possession.

Their Lordships take this as a deliberate finding that the respondent's labels were calculated to enable the respondent's goods to be passed off as the appellant's goods. There was not only abundant evidence to support such a finding but, in their Lordships' opinion, it was clearly right. As the judge appreciated, the respondent by the contrasting colouring of his label, emphasised thereon an essential part of the appellant's trade mark, namely, the red fish. Whilst the respondent had the right under section 22 of the Trade Marks Ordinance to use his registered mark in any colour, which their Lordships will assume without deciding, means in any combination of colours, the existence of this right would not afford him any defence to the charge of using his mark or label as to enable a passing off to be effected. In their Lordships' view, the prominence given to the two fish on the respondent's label was the circumstance which did enable the two traders who gave evidence to pass off the respondent's tea for that of the appellant, as undoubtedly they did. That feature of the respondent's label was evidently effective to satisfy the traders' customers who were given the respondent's tea in response to their request for red or gold fish brand tea that they were getting what they asked for. It was not merely established that the placement and colouring of the fish on the respondent's label was calculated to deceive — as the two traders themselves clearly recognised — but it was established that it had in fact deceived their customers. On this finding of the trial judge, his orders were properly made.

But the respondent argues, first that such a case was not open on the appellant's pleadings, and secondly that, the trial judge's other findings in the case were quite inconsistent with the finding with which their Lordships have just dealt.

The respondent in support of the first submission, places great emphasis upon the association in the appellant's statement of claim of other features than the red fish as having become distinctive of the appellant's goods. Because of this circumstance it was sought to be said that the appellant could not make a case that the use

of its registered mark over many years had caused the public to call for and recognise the appellant's tea by the dominant feature of his mark — namely the red fish. Their Lordships find no substance in this point or in the respondent's attempt to limit the terms of the statement of claim. In their Lordships' opinion, the case actually made by the appellant and dealt with by the trial judge was clearly set up in the pleadings.

The respondent's second submission has caused their Lordships much difficulty, particularly as it seems to have found favour with the Federal Court which set aside the order which had been made by the High Court. The findings to which the respondent refers and which he claims to be inconsistent with the ultimate finding and the order made against the respondent are first, the finding that there had been no infringement of the appellant's trade mark and second, the finding that there was no possibility of confusion by the respective labels in the minds of the public, derived it is said by combining two of the passages which their Lordships have quoted from the judge's reasons. The respondent also says that the Federal Court made the same findings. Therefore, in so far as these are findings of fact, and the respondent claims that the latter of them clearly is purely a finding of fact, there are concurrent findings which according to their usual practice their Lordships ought not to disturb.

The Federal Court read the trial judge's reasons as involving a finding that "the get up of the appellant's goods would not lead to confusion with those of the respondent." There being no fraudulent or deliberate intent to deceive, that court felt that upon this finding the trial judge could only have dismissed the action. But in their Lordships' opinion, the learned judge did not make any such sweeping finding. It is proper to read the passages which have been quoted from his reasons for judgment in the light of his ultimate finding. It is not appropriate in their Lordships' view to displace that finding by a narrow and perhaps unduly literal reading of his earlier expressed reasons. That the judge did not consider himself as making any contradictory statements is plain enough. He should be credited with intending consistent findings and his reasons considered accordingly. He was conscious of the importance to the disposal of the case of the manner in which trade in tea and tea dust was conducted in the community in which the use of the respondent's label was made. He realised that purchases were not made by specifying the label or by comparison of labels. With the express evidence before him of the two traders that they were quite able to distinguish one label from the other without suggestion of confusion, he seems to have thought that that evidence disposed of a case of "actual confusion in the minds of the public," by which their Lordships take him to mean, in the minds of a public comparing one label as a whole or a recollection of it as a whole with the other label. He had no other evidence on the point except the labels themselves, upon which a different conclusion might possibly have been drawn. But apparently in face of the traders' evidence, the judge did not wish to rely upon impressions gained from the labels. Consequently he found that "the respective labels" did not cause actual confusion, and that the traders' evidence did not support a contention that such confusion was possible.

This finding thus understood is not in their Lordships' view inconsistent with the finding that, none the less, particularly in the community in which the appellant's and the respondent's tea retailed, the emphasis by the respondent in his label of an essential part of the appellant's trade mark was calculated to enable a passing off to take place. Clearly the judge did not find that the respondent's label was incapable of enabling the deceit of the customers. He could scarce have done so for the evidence established that that is precisely what the respondent's label did do. He perceived the significance of the manner of trading in bringing about the result in *Schweppes* v. *Gibbens, supra,* and realised the significance of the manner of trading in the instant case in reaching the conclusion to which he ultimately came. Consequently, even if it was rightly found that there was no possibility of confusion in the mind of a purchaser who had the labels to compare or who, seeing the one carried a lively recollection of the other, it could properly be found, and in their Lordships' view in this case it was rightly found, that the respondents' label was calculated to enable a passing off of the respondent's tea in the retail trade in tea or tea dust.

Having reached this conclusion there is no need for their Lordships to consider whether there was in truth a concurrent finding of fact in this connection. It may well be doubted whether the Federal Court in endorsing the trial judge's finding, understood that finding in the sense which has commended itself to their Lordships and intended to endorse it in that sense. Nor is it necessary for their Lordships to consider whether, assuming that for that reason there is not a concurrent finding, the trial judge's finding as to the possibility of confusion, or the Federal Court's finding that the get up of the respondent's goods would not lead to confusion, was right. It is sufficient that the trial judge's ultimate finding was right and adequate to support the orders he made.

It is necessary however before disposing of

the appeal to refer to the finding that there was no infringement by the respondent's label of the appellant's registered marks. It is quite clear in their Lordships' opinion that the respondent cannot rely upon the rights which registration of his own trade mark might have given him in this connection: for, in their Lordships' view, he did not use his registered mark on the labels of which complaint is made.

The appellant sought to challenge before their Lordships the judge's finding that there was no infringement, and there is much force in what he has had to say. But there was no cross appeal against it. Some discussion of it appears to have been allowed in the Federal Court of Malaysia, but upon what footing does not appear.

There is no necessary inconsistency between a finding of no infringement and a finding of passing off, these findings are not so easy to reconcile where as here the court of first instance has placed its finding as to passing off on the central circumstance that the respondent has used an essential feature of the appellant's mark. It may be that if such decisions as *Saville Perfumery Ltd.* v. *June Perfect Ltd.*[3] and *Cordova & Ors.* v. *Vick Chemical Co.*[4] had been before him the learned trial judge might well have found infringement. However, as there was no cross appeal, their Lordships prefer not to enter upon the question whether or not the trial judge's finding of no infringement is supportable. The claim to an injunction to restrain the passing off is sufficient for the appellant's purposes and, little, if any, practical consequence could flow from the reversal of the finding of no infringement.

Their Lordships will report to the Head of Malaysia their opinion that the appeal should be allowed and the orders made upon the passing off claim restored, and that the respondent should pay the appellant's costs of this appeal and of the proceedings in the Federal Court of Malaysia.

Appeal allowed.

Solicitors: *Lawrence, Messer & Co.; McKenna & Co.*

STANISLAUS KROFAN & ANOR. v. PUBLIC PROSECUTOR

[F.C. (Wee Chong Jin C.J., Tan Ah Tah F.J. and Ambrose J.) October 5, 1966]

[Singapore — Federal Court Criminal Appeal No. Y4 of 1966]

Internal Security — Possession of explosives — Whether Geneva Conventions are part of domestic law in Singapore — Question not raised at the trial — Internal Security Act, 1960, s. 57(1).

International law — Geneva Convention Relative to the Treatment of Prisoners of War — Hague Regulations relating to the laws and customs of war on land — Position of members of the armed forces of foreign belligerent State found acting as saboteurs in civilian clothes — Whether prisoners of war.

The appellants, members of the Indonesian armed forces, were convicted of carrying explosives, an offence under the Internal Security Act, 1960. On appeal the question was raised whether the 1949 Geneva Convention Relative to the Treatment of Prisoners of War was part of the domestic law in Singapore and whether the appellants were prisoners of war within the meaning of that Convention.

Held: (1) as the question of the applicability of the Geneva Conventions was raised at a very late stage of the proceedings the court would decline to decide it and would assume that they were applicable to Singapore at all material times;

(2) a regular combatant who chooses to divest himself of his most distinctive characteristic, his uniform, for the purpose of spying or of sabotage thereby forfeits his right on capture to be treated as a prisoner of war;

(3) the appellants in this case had forfeited their rights to be treated as prisoners of war and therefore were rightly tried and convicted.

Case referred to:—

(1) *The Saboteurs' Case (Ex parte Quirin & Ors.)* (1940), 317 U.S. 1; Annual Digest 1941 — 1942 — Case No. 168; 87 Law. Ed. 3.

FEDERAL COURT.

G. Murugayan for the appellants.

Francis Seow (Senior State Counsel) for the respondent.

Cur. Adv. Vult.

Wee Chong Jin C.J.: The appellants were tried, convicted and sentenced by the High Court in Singapore on the following charge:—

"That you (1) Stanislaus Krofan (2) Andres Andea, on or about the 14th day of April, 1965, at about 9.20 p.m. at Tanjong Rhu, Singapore, which is a security area, did carry without lawful authority 43 lbs. of explosives, and thereby committed an offence under section 57(1)(b) and punishable under section 57(1) of the Internal Security Act, 1960."

We propose to set out only those facts which are material for determining the questions raised in this appeal. The appellants on the evening of 14th April 1965 came into Singapore from one of the nearby Indonesian islands in a boat which carried no lights. They came ashore carrying with them explosives which they claimed they had been ordered by their superiors to explode in Singapore. They claimed they were members of the armed forces of Indonesia though at the time of their entry into Singapore they were wearing civilian clothing. They were apprehended without offering any resistance immediately after they set foot on Singapore soil with the explosives in their physical possession. At the material date there was a state of "confrontation" between Indonesia and Malaysia, of which Singapore was a member State. For the purposes of this appeal it is not disputed that as a result of this state of confrontation, Indonesia and Malaysia were in "armed conflict" within the meaning of that expression in the